



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Adam Levine et al. On Appeal to the Board of
Appeals and Interferences
Serial No. : 09/883,516
Filed : June 18, 2001 Examiner: Steven S. Paik
For : SCANNER PAIRING IN A Art Unit: 2876
BLUETOOTH POS NETWORK

BRIEF ON APPEAL

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26,946

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STATUTE(S)

35 U.S.C. § 103(a)	Passim
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BRIEF ON APPEAL

I. REAL PARTY IN INTEREST

This application has been assigned by the inventors Adam Levine and Stephen J. Shellhammer to Symbol Technologies, Inc., who is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

The applicant and the applicant's legal representatives are unaware of any appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-8 have been rejected under 35 U.S.C. §103(a) as obvious in view of U.S. Patent No. 6,424,830 (O'Hagan et al.) further in view of U.S. Patent No. 5,825,002 (Roslak). No claims are allowed. Appellant appeals from the Final Rejection of pending claims 1-8, which are set forth in the Appendix to this brief.

IV. STATUS OF AMENDMENTS

No new amendments have been requested.

V. SUMMARY OF INVENTION

Applicant's invention relates to a method and apparatus to initiate communication between a master device and a slave device in which the slave device communicates with the master device over a radio data communications link. For example, a portable device, such as a portable bar code scanner, may be used to acquire data from bar codes of items purchased and the data may then be communicated to a point of sale (POS) terminal by wireless data communication. The wireless data communication uses a master/slave protocol where the master radio module is part of the POS terminal and the slave radio module is part of the portable bar code scanning device. The portable bar code scanning device includes a bar code on the outside of the housing to identify the portable device. By scanning the bar code of a portable device with a scanner of a specific POS terminal, such as a fixed scanner built onto a counter, the master/slave radio communications link can be automatically established. Accordingly, the present claimed invention provides a fast and convenient way to establish a communications link between an individual portable scanner and a specific POS terminal.

VI. ISSUES ON APPEAL

The issue on appeal is whether the Examiner failed to establish a *prima facie* case that claims 1-8, which stand rejected under 35 U.S.C. § 103(a), are obvious in view of U.S. Patent No. 6,424,830 (O'Hagan et al.) further in view of U.S. Patent No. 5,825,002 (Roslak).

VII. GROUPING OF THE CLAIMS

For purposes of this appeal, all claims stand or fall together.

VIII. ARGUMENT

A. Relevant Legal Standards

To reject claims in an application under 35 U.S.C. § 103(a), an examiner must show an unrebutted *prima facie* case of obviousness. *see In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998). The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

Therefore, to sustain a rejection under 35 U.S.C. § 103(a), there must be some teaching, other than the instant application, to alter the prior art and arrive at the claimed invention. To establish obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). “The problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem.” *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 679 (Fed. Cir. 1998).

Thus, to establish a *prima facie* case of obviousness, the examiner has an obligation to construe the scope of the prior art, identify the differences between the claims and the prior art, and determine the level of skill in the pertinent art at the time of the invention. From this, the examiner must provide a positive reason why it would be obvious to modify the prior art to arrive at the claimed invention. Absent an explanation of “the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of [applicant’s] invention to make the combination, [there is an inference] that the examiner selected these references with the

assistance of hindsight,” which is clearly impermissible. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). A positive suggestion or motivation to alter the prior art is a requisite safeguard against hindsight being used to negate patentability. *Id.* at 1459.

“Multiple cited prior art references *must suggest the desirability* of being combined and the reference must be viewed without the benefit of *hindsight* afforded to the disclosure. *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994); *emphasis added*. “It is improper to use the inventor’s disclosure as a road map for selecting and combining prior art disclosures.” *See Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not be based on Appellant’s disclosure. *See In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

When combining references for purposes of demonstrating obviousness of the claimed invention, the first requirement is that a suggestion, teaching, or motivation to combine the prior art references be shown. *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing is an “essential evidentiary component of an obviousness holding.” *Id.*, emphasis added. This evidence may flow from the (1) prior art references themselves, (2) the knowledge of one of ordinary skill in the art, or, in some cases, (3) from the nature of the problem to be solved. *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000), *citing Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed.Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. *See In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). “This showing must be clear and

particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000); emphasis added.

B. The Rejection

The sole issue in this Appeal is whether the Examiner failed to establish a *prima facie* case that claims 1-8, which stand rejected under 35 U.S.C. § 103(a), are obvious in view of U.S. Patent No. 6,424,830 (O'Hagan et al.) further in view of U.S. Patent No. 5,825,002 (Roslak). It is alleged that O'Hagan et al. discloses a POS system for acquiring bar code data relating to a transaction where a first bar code scanner is arranged to scan bar codes and provides data to a processor and a second portable bar code scanner which includes a radio module. The examiner states that O'Hagan does not disclose or fairly suggest that the second scanner includes an identifying bar code representing an IP address or a network address of the device. (Official Action; page 2, paragraph 3) Instead, it is alleged that Roslak discloses an identifying bar code that identifies each bar code reader.

However, Roslak discloses a method for securely updating data in a self-checkout system in which a user activates a portable bar code reader from a plurality of reader slots in a dispenser unit. The bar code is located in the slot of the dispenser unit and when the bar code reader is locked into place, the bar code can be read by the bar code reader and communicated to the central processor. Each of the slots is physically and electronically marked to identify the location of the bar code reader in that slot. (*see* col. 3 lines 38-50) The examiner states that, therefore, the bar code reader and the reader slot may be broadly interpreted as one reading unit. However, Roslak discloses that the bar code in the slot of the dispenser is used to identify the physical location of the bar code reader by the central processor (*see* col. 3 lines 45-46). In

contrast, the present invention discloses a bar code, or other identifying data, on the portable scanner that is used relay information necessary to establish a master/slave communications link between the portable scanner and a specific POS terminal.

Roslak also discloses that the system console may be provided with a separate bar code receiver at a service desk console for the purpose of communicating with the bar code reader. (col. 7 lines 5-7). The examiner asserts that this "implicitly" suggests that the bar code reader can be read by the system console. However, Roslak discloses that "communication between the bar code reader and the central processing unit is completed through a communication network which may consist of either a wired communication bus which [is] coupled through a port on the bar code reader when it is placed in the dispenser unit, or through an RF network which is active when the bar code reader is placed in the terminal dispenser." (*see* col. 4; lines 33-40) Consequently, one skilled in the art would interpret that the separate bar code receiver at the service desk console is an additional wired communications bus or a RF network active when the reader is placed in a dispenser located at the service desk and not a bar code, or other identifying data, on the scanner used to establish a master/slave communications link.

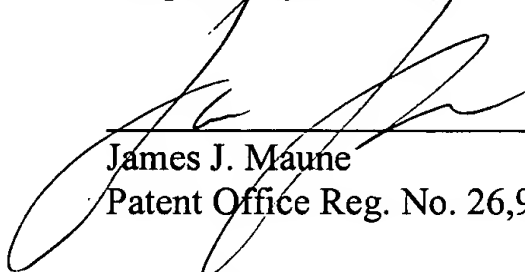
To establish obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. Neither O'Hagan et al. nor Roslak teach or suggest a bar code, or any identification data, on a slave device, such as a portable scanner, to identify the specific slave device. Furthermore, neither O'Hagan et al. nor Roslak teach or suggest that data on a slave device may be used to associate the slave unit with a master unit to establish a master/slave communications link. Therefore, the references taken alone or together do not teach or suggest all the claim limitations of the present invention. Furthermore, to establish

obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the teachings. The mere fact that references might be modified is not enough to constitute obviousness unless the prior art also suggests the desirability of the modification. Since there is no suggestion or motivation in the references themselves or in the knowledge generally available to one skilled in the art, to modify the references, a *prima facie* case that the claims of the present invention are obvious in view of U.S. Patent No. 6,424,830 (O'Hagan et al.) further in view of U.S. Patent No. 5,825,002 (Roslak) has not been established.

IX. CONCLUSION

For the reasons indicated above, Appellant respectfully submits that the invention recited in each of the claims of the present application as provided herein is new and non-obvious. Reversal of the Examiner's rejections of the claims is therefore respectfully requested.

Respectfully submitted,



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APPENDIX TO BRIEF ON APPEAL

The pending claims are as follows:

1. In a point of sale system for acquiring bar code data relating to a transaction, wherein a first bar code scanner is arranged to scan bar codes and provide data relating to scanned bar codes to a processor, the improvement comprising a second portable bar code scanner, said second scanner including a slave radio module for acting as a slave unit using a master-slave data communication protocol and said second scanner including an identifying bar code individually identifying said second scanner, and wherein there is provided a master radio module associated with said point of sale system and wherein said master radio module is arranged to act as a master for communication with said slave radio module in response to reading of said identifying bar code on said second scanner by said first bar code scanner.
2. The improvement specified in claim 1 wherein said identifying bar code is representative of a data communication address for said slave radio.
3. The improvement specified in claim 1 wherein said processor includes a memory having a data communication address for said slave radio associated with data representing said identifying bar code.
4. The improvement specified in claim 1 wherein said master radio module is arranged to discontinue acting as a master for communication with said slave radio module in response to a further reading of said identifying bar code.

5. A method for establishing a master/slave data communication link between a master device and a slave device, comprising:

providing a machine readable identification device on a slave device, said identification device including identification data individually identifying said slave device;

reading said identification device with a reader, other than said slave device, associated with said master unit to obtain said identification data;

determining a slave address of said slave device from said identification data; and

operating said master unit to associate with said slave device using said slave address.

6. A method for reading bar codes on items to be purchased, comprising:

providing a portable bar code reader having a slave radio module having a slave address for providing data communication and an identifying bar code on said reader;

reading said identifying bar code with a second bar code reader associated with a master radio module and a data processor to obtain identifying data;

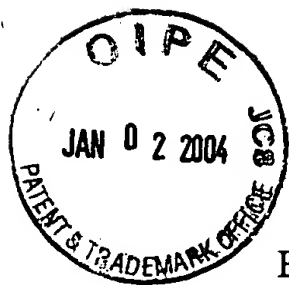
determining said slave address using said identifying data;

operating said master unit to associate with said slave unit; and

using selectively said portable bar code reader and said second bar code reader to read bar codes and provide data to said processor.

7. A portable bar code scanner comprising a housing enclosing a slave radio data transceiver having a network address and an optical bar code reader and a bar code on the exterior of said housing, said bar code being associated with said network address.

8. A terminal having a processor, a bar code reader, a master radio module for providing data communications and a program for operating said processor, said program being arranged to operate said bar code reader and provide data to said processor, operate said processor to recognize said data as data identifying a slave unit and operate said master radio module to conduct data communications with said slave unit.



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James J. Maune

Attorney Name

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No new amendments have been requested.

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Applicant's invention relates to a method and apparatus to initiate communication between a master device and a slave device in which the slave device communicates with the master device over a radio data communications link. For example, a portable device, such as a portable bar code scanner, may be used to acquire data from bar codes of items purchased and the data may then be communicated to a point of sale (POS) terminal by wireless data communication. The wireless data communication uses a master/slave protocol where the master radio module is part of the POS terminal and the slave radio module is part of the portable bar code scanning device. The portable bar code scanning device includes a bar code on the outside of the housing to identify the portable device. By scanning the bar code of a portable device with a scanner of a specific POS terminal, such as a fixed scanner built onto a counter, the master/slave radio communications link can be automatically established. Accordingly, the present claimed invention provides a fast and convenient way to establish a communications link between an individual portable scanner and a specific POS terminal.

VI. ISSUES ON APPEAL

The issue on appeal is whether the Examiner failed to establish a *prima facie* case that claims 1-8, which stand rejected under 35 U.S.C. § 103(a), are obvious in view of U.S. Patent No. 6,424,830 (O'Hagan et al.) further in view of U.S. Patent No. 5,825,002 (Roslak).

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A. Relevant Legal Standards

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Therefore, to sustain a rejection under 35 U.S.C. § 103(a), there must be some teaching, other than the instant application, to alter the prior art and arrive at the claimed invention. To establish obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). “The problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem.” *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 679 (Fed. Cir. 1998).

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“Multiple cited prior art references *must suggest the desirability* of being combined and the reference must be viewed without the benefit of *hindsight* afforded to the disclosure. *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994); *emphasis added*. “It is improper to use the inventor’s disclosure as a road map for selecting and combining prior art disclosures.” *See Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not be based on Appellant’s disclosure. *See In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

When combining references for purposes of demonstrating obviousness of the claimed invention, the first requirement is that a suggestion, teaching, or motivation to combine the prior art references be shown. *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing is an “essential evidentiary component of an obviousness holding.” *Id.*, *emphasis added*. This evidence may flow from the (1) prior art references themselves, (2) the knowledge of one of ordinary skill in the art, or, in some cases, (3) from the nature of the problem to be solved. *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000), *citing Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed.Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. *See In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). “This showing must be clear and

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B. The Rejection

The sole issue in this Appeal is whether the Examiner failed to establish a *prima facie* case that claims 1-8, which stand rejected under 35 U.S.C. § 103(a), are obvious in view of U.S. Patent No. 6,424,830 (O'Hagan et al.) further in view of U.S. Patent No. 5,825,002 (Roslak). It is alleged that O'Hagan et al. discloses a POS system for acquiring bar code data relating to a transaction where a first bar code scanner is arranged to scan bar codes and provides data to a processor and a second portable bar code scanner which includes a radio module. The examiner states that O'Hagan does not disclose or fairly suggest that the second scanner includes an identifying bar code representing an IP address or a network address of the device. (Official Action; page 2, paragraph 3) Instead, it is alleged that Roslak discloses an identifying bar code that identifies each bar code reader.

However, Roslak discloses a method for securely updating data in a self-checkout system in which a user activates a portable bar code reader from a plurality of reader slots in a dispenser unit. The bar code is located in the slot of the dispenser unit and when the bar code reader is locked into place, the bar code can be read by the bar code reader and communicated to the central processor. Each of the slots is physically and electronically marked to identify the location of the bar code reader in that slot. (*see* col. 3 lines 38-50) The examiner states that, therefore, the bar code reader and the reader slot may be broadly interpreted as one reading unit. However, Roslak discloses that the bar code in the slot of the dispenser is used to identify the physical location of the bar code reader by the central processor (*see* col. 3 lines 45-46). In

contrast, the present invention discloses a bar code, or other identifying data, on the portable scanner that is used relay information necessary to establish a master/slave communications link between the portable scanner and a specific POS terminal.

Roslak also discloses that the system console may be provided with a separate bar code receiver at a service desk console for the purpose of communicating with the bar code reader. (col. 7 lines 5-7). The examiner asserts that this "implicitly" suggests that the bar code reader can be read by the system console. However, Roslak discloses that "communication between the bar code reader and the central processing unit is completed through a communication network which may consist of either a wired communication bus which [is] coupled through a port on the bar code reader when it is placed in the dispenser unit, or through an RF network which is active when the bar code reader is placed in the terminal dispenser." (*see* col. 4; lines 33-40) Consequently, one skilled in the art would interpret that the separate bar code receiver at the service desk console is an additional wired communications bus or a RF network active when the reader is placed in a dispenser located at the service desk and not a bar code, or other identifying data, on the scanner used to establish a master/slave communications link.

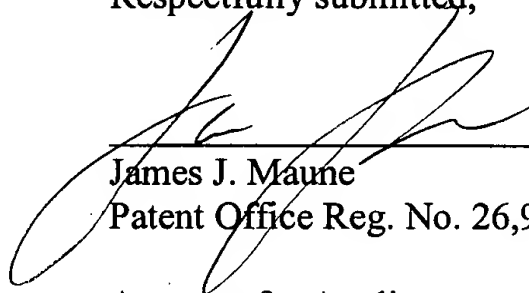
To establish obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. Neither O'Hagan et al. nor Roslak teach or suggest a bar code, or any identification data, on a slave device, such as a portable scanner, to identify the specific slave device. Furthermore, neither O'Hagan et al. nor Roslak teach or suggest that data on a slave device may be used to associate the slave unit with a master unit to establish a master/slave communications link. Therefore, the references taken alone or together do not teach or suggest all the claim limitations of the present invention. Furthermore, to establish

obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the teachings. The mere fact that references might be modified is not enough to constitute obviousness unless the prior art also suggests the desirability of the modification. Since there is no suggestion or motivation in the references themselves or in the knowledge generally available to one skilled in the art, to modify the references, a *prima facie* case that the claims of the present invention are obvious in view of U.S. Patent No. 6,424,830 (O'Hagan et al.) further in view of U.S. Patent No. 5,825,002 (Roslak) has not been established.

IX. CONCLUSION

For the reasons indicated above, Appellant respectfully submits that the invention recited in each of the claims of the present application as provided herein is new and non-obvious. Reversal of the Examiner's rejections of the claims is therefore respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'James J. Maune', is written over a horizontal line.

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APPENDIX TO BRIEF ON APPEAL

The pending claims are as follows:

1. In a point of sale system for acquiring bar code data relating to a transaction, wherein a first bar code scanner is arranged to scan bar codes and provide data relating to scanned bar codes to a processor, the improvement comprising a second portable bar code scanner, said second scanner including a slave radio module for acting as a slave unit using a master-slave data communication protocol and said second scanner including an identifying bar code individually identifying said second scanner, and wherein there is provided a master radio module associated with said point of sale system and wherein said master radio module is arranged to act as a master for communication with said slave radio module in response to reading of said identifying bar code on said second scanner by said first bar code scanner.

2. The improvement specified in claim 1 wherein said identifying bar code is representative of a data communication address for said slave radio.

3. The improvement specified in claim 1 wherein said processor includes a memory having a data communication address for said slave radio associated with data representing said identifying bar code.

4. The improvement specified in claim 1 wherein said master radio module is arranged to discontinue acting as a master for communication with said slave radio module in response to a further reading of said identifying bar code.

5. A method for establishing a master/slave data communication link between a master device and a slave device, comprising:

providing a machine readable identification device on a slave device, said identification device including identification data individually identifying said slave device;

reading said identification device with a reader, other than said slave device, associated with said master unit to obtain said identification data;

determining a slave address of said slave device from said identification data; and

operating said master unit to associate with said slave device using said slave address.

6. A method for reading bar codes on items to be purchased, comprising:

providing a portable bar code reader having a slave radio module having a slave address for providing data communication and an identifying bar code on said reader;

reading said identifying bar code with a second bar code reader associated with a master radio module and a data processor to obtain identifying data;

determining said slave address using said identifying data;

operating said master unit to associate with said slave unit; and

using selectively said portable bar code reader and said second bar code reader to read bar codes and provide data to said processor.

7. A portable bar code scanner comprising a housing enclosing a slave radio data transceiver having a network address and an optical bar code reader and a bar code on the exterior of said housing, said bar code being associated with said network address.

8. A terminal having a processor, a bar code reader, a master radio module for providing data communications and a program for operating said processor, said program being arranged to operate said bar code reader and provide data to said processor, operate said processor to recognize said data as data identifying a slave unit and operate said master radio module to conduct data communications with said slave unit.